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EXAMINER				
DURAN, ARTHUR D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,480

Applicant(s)

LIAO ET AL

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 24-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 24-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-13 and 24-39 have been examined.

Election/Restrictions

Applicant's confirmation of the election without traverse of Gorup I, claims 1-13 and 24-29 in the reply filed on 1/22/08 is acknowledged.

Response to Amendment

The Amendment filed on 6/25/08 is sufficient to overcome the prior rejection. A new reference has been added to the 35 USC 103 rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 describes "interactively distributing". The Examiner could find interactive television in the Specification. The Examiner could not find any interactively distributing of a coupon in the Specification. Hence, it is unclear what interactively distributing of a coupon is or how it occurs.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-13 and 24-29, 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mittal (2003/0154125) in view of Dureau (2002/0056112).

Claim 1, 7, 24, 27: Mittal discloses a system for conditionally redeeming an electronic coupon, comprising:

a distribution module distributing an adaptive electronic coupon to a user;

electronic coupon metadata automatically changing redemption characteristics of

the coupon post distribution based on predetermined conditions relating to personal data of the user and a redemption environment;

a redemption system honoring the adaptive electronic coupon at a time and place of redemption based on the predetermined conditions relating to the personal data of the user and

the redemption environment (Fig. 12; [70-76]; [59]; [60]; [61]; [48]; [101-110]; Abstract).

Mittal further discloses an active display adapted to visually render an electronic coupon according to the electronic coupon data and variable expiration terms associated therewith ([48]; [49]; [53]; Fig. 13).

Mittal discloses a mobile user utilizing a handheld device ([112]) and a variety of computer related devices ([115], [126]).

Mittal further discloses that a household can be targeted ([88]).

Mittal further discloses that user viewing activity can be used for targeting (Fig. 6; Fig. 8, "customer online or in an interactive environment").

Mittal does not explicitly disclose that the distribution device is a household device that transmits to a user handheld device.

Mittal does not explicitly disclose a handheld device receiving and storing the electronic coupon and the metadata, wherein said handheld device is adapted to provide redemption information about the electronic coupon to said redemption system by data communication with a cash register of a retailer at the time and place of redemption.

However, Dureau discloses wirelessly transmitting coupon information from a distribution device to a handheld device and then taking the handheld device to a physical store for redemption (Fig. 1; [62,63]).

And, since Dureau uses a wirelessly transmitting device for storing the coupons, and since Dureau states that the device can be taken to the store for redemption, it is obvious that the wireless capabilities of the device can be used for further communication related to the coupon.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dureau's coupons transmitted wirelessly to a user to Mittal's coupons and a mobile user utilizing a handheld device or variety of devices. One would have been motivated to do this in order to better allow the user further access to coupons.

Mittal further discloses utilizing predetermined ranges and predetermined rules (Claims 10-14) and predetermined classes (Claim 26) related to coupons.

Additionally, Mittal discloses a distribution model interactively distributing ([74]; claim 11, 40; or, Fig. 8, Fig. 6; Fig. 8, "customer online or in an interactive environment") an adaptive electronic coupon having electronic coupon metadata ([44]; claim 6, 19) to a user based on at least one predetermined rule (claim 11).

Also, Examiner notes that Applicant's metadata was interpreted in light of Applicant's Specification such as Applicant's paragraph [65] ([65]).

Also, in regards to claim 27, Mittal discloses that the electronic coupon adjusts metadata prior to distribution based on interactions between the handheld device and a distribution model of the electronic coupon ([44]; claim 6, 19, 11; Figures 6, 8).

Claim 2, 10: Mittal discloses the system of claim 1, comprising a verification system verifying that the predetermined conditions have been met at the time and place of redemption (Fig. 12).

Claim 3: Mittal discloses The system of claim 1, wherein the redemption characteristics correspond to a redemption category and a redemption value (Fig. 12; Claims 10-14; [53]; and above claim 1 rejection).

Claim 4, 11: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a time of redemption (see above claim 1 rejection).

Claim 5, 12, 26, 28: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a place of redemption (see above claim 1 rejection).

Claim 6, 13: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a weather condition at a time and place of redemption ([48]).

Claim 8: Mittal discloses the method of claim 7, wherein said distributing the adaptive electronic coupon to the user corresponds to distributing the adaptive electronic coupon to the user, wherein the adaptive electronic coupon has a redemption category, a redemption value, and adaptability metadata defining dependency of at least one of the redemption category and the redemption category on the predetermined conditions (Fig. 12; Claims 10-14; [53]; and above claim 7 rejection).

Claim 9: Mittal discloses the method of claim 8, wherein said automatically changing redemption characteristics of the coupon based on predetermined conditions relating to personal data of the user and a redemption environment corresponds to changing at least one of the redemption category and the redemption value according to the predetermined conditions (Fig. 12; Claims 10-14; [53]; and above claim 7 rejection).

Claim 25, 29: Mittal discloses the portable viewer of claim 24 wherein said metadata includes at least one datum for mediating redemption expiration terms ([48]; [49]; [53]).

Claim 32: The prior art renders obvious said distribution module is media content consumption equipment responsive to remote control signals from the handheld device to control presentation of a plurality of media content selections to the user, the electronic coupon is associated with a designated one of the media content selections, and the media content consumption equipment wirelessly transmits the electronic coupon to the handheld device contingent upon the user accessing the designated one of the media content selections (Please see the rejection of the independent claims above and the rejection of claims 30, 31 preceding).

Claim 33: Mittal further discloses that the cash register is adapted to prompt an operator of the cash register to verify that the predetermined conditions have been met ([86]).

Claim 34: Mittal further discloses that the electronic coupon becomes invalid a predetermined amount of time after performance of the data communication ([32, 44, 48, 49]).

Claim 35: Mittal further discloses the distribution module determines availability of the adaptive electronic coupon to the user by applying the at least one predetermined rule to interactions of the user with the distribution module in a predetermined time window (Fig. 11; [48]; [98-100; [110]).

Claim 36: Mittal further discloses the distribution module further adjusts the metadata of the adaptive electronic coupon by applying the at least one predetermined rule to the interactions of the user ([44]; claim 6, 19, 11).

Claim 37: The prior art discloses wherein the distribution module is a household module (please see Dureau cited in claim 1).

Claim 38: The prior art discloses wherein the household module is one of a television receiver, an audio/video equipment, a set top box, and an interactive entertainment system (please see Dureau cited in claim 1).

Claim 39: The prior art further discloses a storage module that preloads data associated with a media content and that is readable by the handheld device, wherein the handheld device communicates with the distribution module to display information based on the data associated with the media content and invites interactions of the user with the distribution module, wherein the handheld device transmits the interactions of the user to the distribution module (Fig. 1, Dureau; and also, the rejection of claim 1 above citing Dureau).

Claims 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mittal (2003/0154125) in view of Dureau (2002/0056112) in view of Webb (2002/0071076).

Claims 30, 31: The prior art discloses the above. Mittal does not explicitly disclose wireless transmission involving a scanner.

However, in regards to Claim 30, Webb further discloses that the cash register has a barcode scanning device, and said handheld device has an active display that performs the data communication by graphically rendering a barcode representing the information for scanning by the barcode scanning device ([85, 3, 12]; Abstract). And, in regards to Claim 31, Webb further discloses that the handheld device performs the data communication by wirelessly transmitting a code to the cash register ([85, 3, 12]; Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Webb's use of a scanner for wireless transmissions to the prior art's wireless transmissions and coupons. One would have been motivated to do this in order to better take advantage of the fact that coupons commonly have bar codes.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant has added new features and

new claims. Please see the addition of the Dureau reference above. Also, the new claims have been rejected above as well.

On page 13 of the Applicant's Remarks dated 6/25/2008, Applicant states in regards to independent claim 1 that the prior art does not render obvious, "a distribution model interactively distributing an adaptive electronic coupon having electronic coupon metadata to a user based on at least one predetermined rule.

However, Mittal discloses a distribution model interactively distributing ([74]; claim 11, 40; or, Fig. 8, Fig. 6; Fig. 8, "customer online or in an interactive environment") an adaptive electronic coupon having electronic coupon metadata ([44]; claim 6, 19) to a user based on at least one predetermined rule (claim 11).

Also, Examiner notes that Applicant's metadata was interpreted in light of Applicant's Specification such as Applicant's paragraph [65] ([65]).

Also, in regards to claim 32, 24, the combination of the prior art discloses wirelessly transmitting a coupon from a set-top device to a user handheld device (Dureau, Fig. 1; [62,63]). Please see the addition of the Dureau reference to the rejection of the independent claims above.

Also, in regards to claim 27, Mittal discloses that the electronic coupon adjusts metadata prior to distribution based on interactions between the handheld device and a distribution model of the electronic coupon ([44]; claim 6, 19, 11; Figures 6, 8).

Examiner further notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking

references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner notes that "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR, 127 S.Ct. at 1739 and 1741, 82 USPQ2d at 1396.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Yamamoto (US007302696B1), Sorensen US006628729B1 and Schneider US 20080016142A1 disclose relevant features for set-top boxes and portable devices related to coupons;

a) Roberts (6,493,110) discloses utilizing a variety of hand-held devices (col 5, lines 45-55).

Roberts disclose that the characteristics of the electronic coupon can be dynamically adjusted based upon user characteristics, including redemption amounts (col 9, lines 25-37; col 16, lines 36-46;).

Roberts further discloses a variety of variable coupon data including location and expiration date information (col 15, lines 52-59).

Roberts further discloses varying coupon information depending upon personal information of the user (col 17, line 60- col 18, line 5).

Roberts further discloses varying coupons based upon a variety of store, user, and utilization information (col 16, line 60-col 17, line 30).

Roberts further discloses adjusting date information (col 16, lines 20-25) and performing actions on coupons based upon coupon expiration date information prior to a time of attempted redemption (col 16, lines 5-39).

b) Denimarck (20030018522) discloses variable coupons related to weather:

"[0057] A method of identifying a customer at one of the customer identification stations 56 will now be described. A customer 58 enters the retail establishment 20 and approaches a customer station 56 (FIGS. 1-3). The customer 58 is identified by entering a pin code into the pin code entry device 68 and providing a biometric characteristic, e.g., thumbprint, to the biometric sensing device 72. A customer record is obtained based on one or more queries including the submitted pin code and biometric characteristic profile. The terminal 60 may prompt the customer via the display 72 of one or more customer options once the customer is identified. One option may be to print one or more shopping coupons (e.g., manufacturers coupon, retail establishment coupon) for the customer's use. The type of shopping coupons and amount may be based on, for example, one or more of the following: the shopping history of the customer, the time of day, the day of the week, the season, the weather, regional preferences, goods in excess supply, goods with an approaching expiration date, etc. Upon selection of this option, one or more relevant coupons may be printed by the printer 64."

c) Hassell (20010042010) discloses variable coupons:

"[0058] Additionally, since the system never loses track of any given coupon

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during its life, coupon information may be changed by the system during its life span and detailed information about the user may be obtained, for example, purchasing habits, likes and dislikes, clipping to usage ratios, etc. Moreover, from the advertiser perspective, important market research information may be obtained. For example, a given advertiser may offer coupons for the same items in differing amounts to determine the discount amount which produces the greatest amount of traffic or sales. Similarly, this information allows an advertiser to offer consumers specifically targeted discounts which are more likely to result in increased sales. In other embodiments, advertisers can implement a micro pricing model whereby the value of a coupon can vary based upon factors such as the hosting website, time of day, duration to expiration, the coupon's transfer history, the popularity, an optimal pricing analysis or the redemption site."

d) Deaton discloses variable coupons and electronic coupons:

"Point-of-sale incentives may be spooled or stored electronically. If incentives NOT previously stored electronically, GOTO 180. 165 Electronic coupons were previously stored and will now be redeemed. Choose media for previous storage of electronic coupons. 166 If coupons stored on a "SMART" Card: 167 AP/M accesses first coupon from "SMART" card using "SMART" card read/write device. 168 If no more coupons, GOTO 180. 169 AP/M sends coupon to CVC controller. 170 CVC controller checks coupon against items purchased. If item was purchased: 171

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Coupon information is sent to ECR Controller. 172 ECR Controller credits customer's purchase amount for value of coupon. 173 CVC Controller updates coupon database to reflect redemption. 174 AP/M access next coupon from "SMART" card. GOTO 168. 175 If coupons stored on mass storage device in CVC controller: 176 CVC Controller accesses first coupon from storage. 177 If no more coupons, GOTO 180. 178 CVC Controller checks coupon against items purchased. If item was purchased: EXECUTE steps 171-173, THEN PROCEED WITH

179. 179 Read next coupon from CVC Controller's mass storage. GOTO 177.

(537) FIG. 34 is a flow chart of the disbursement of point-of-sale incentives either by the printing out of a coupon or by storage of electronic funds on a smart card or by a mass storage device at the controller 965"

e) Barnett (6,321,208) disclose variable coupons:

Barnett discloses that the coupons are fully digital promotions as they can be electronically sent and/or electronically redeemed (col 11, lines 33-45). And, furthermore, each field of the coupon is known and tracked as coupons can be deleted based upon the expiration date field of the coupon (col 11, line 64-col 12, line 6). Also, specific coupon data or coupon fields are known and can be electronically changed (col 12, lines 5-10; col 13, lines 24-35). Barnett further disclose that specific fields of coupons are known, tracked, and variable (col 12, lines 19-25; col 13, lines 24-35; col 12, lines 44-50). Barnett further discloses tracking historic buying profiles of users (col 8, lines 17-20). Furthermore, note the extensive information available relevant to

purchasing and/or coupons (Fig. 2; Fig. 3; Fig. 5; Fig. 10; and citations from rejection above).

Hence, the coupon of Barnett is a fully digital promotion, with information that can be tracked, recorded, or adjusted for different fields of the coupon where the different fields of the coupon can be adapted/adjusted before or after being given to the user according to user purchasing history, selection of coupons, utilization of coupons, redemption of coupons. Furthermore, the information tracked concerning a user and/or coupons includes extensive information related to purchasing and/or coupon utilization.

And, as a further note, Barnett does disclose comparing different stores, comparing different items from different stores, comparing coupons available to items available at different stores (col 10, lines 15-46; Fig. 2, item 30e) and assessing and comparing the prices of items in order to adjust pricing relative to users (col 13, lines 24-35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/

Primary Examiner, Art Unit 3622

7/28/2008